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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/682,422 | 08/31/2001 | John Joseph DiEnno | 9D-DW-19893 | 7785 |
| 23465 | 7590 | 10/29/2008 | | |
| JOHN S. BEULICK C/O ARMSTRONG TEASDALE, LLP ONE METROPOLITAN SQUARE SUITE 2600 ST LOUIS, MO 63102-2740 | | | EXAMINER HANSEN, JAMES ORVILLE | |
| | | | ART UNIT 3637 | PAPER NUMBER |
| | | | NOTIFICATION DATE 10/29/2008 | DELIVERY MODE ELECTRONIC |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USpatents@armstrongteasdale.com

Office Action Summary

Application No.

09/682,422

Applicant(s)

DIENNO ET AL.

Examiner

James O. Hansen

Art Unit

3637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-7 and 9-21 is/are pending in the application.
- 4a) Of the above claim(s) 3, 6 and 10-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 5, 7, 9 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 29, 2008 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 4, 5, 7, 9 & 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sulcek [U.S. Patent No. 4,478,465] in view of Vogler [U.S. Patent No. 5,625,969]. Sulcek (figures 1-4) teaches of an "escutcheon" for an appliance door assembly, the escutcheon [see Exhibit D] comprising: a front edge and a rear edge horizontally spaced from the front edge, the front and rear edges vertically depending from an escutcheon upper surface; a control panel mounting portion comprising a mounting surface and a lower edge, the control panel mounting portion extending upwardly and inwardly from the lower edge and between the front and rear edges, the control panel mounting portion including a plurality of inherent openings there through

that accept bolts; and a plurality of formations downwardly from the lower edge, the formations comprising a flange and a lip combining to define a retaining slot configured to receive a panel such that the panel and lower edge form a substantially flush surface [in as much as applicant's depiction of this limitation in figure 5 may be considered a substantially flush surface]. The flange extends at an acute angle from the lip in as much as applicant's depiction of this claimed feature {fig. 5} is similar in structure to Sulcek's depiction {note lower curved section of Sulcek's flange}. Accordingly, the position is taken that Sulcek teaches all the claimed limitations of applicant's inventive structure except for the incorporation of a plurality of positioning ribs that extend into the retaining slot. Vogler (figures 1-5) is cited as an evidence reference to show that it was known in the panel securing art to utilize positioning ribs (R) within a retaining slot (fig. 3) for the purpose of securing a panel (P) within the slot. The ribs comprising a reinforcing section (viewed as the section upon which the ribs are attached – so far as broadly claimed) configured to prevent flexing of the ribs. Accordingly, the position is taken that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the device of Sulcek so as to incorporate positioning ribs within the retaining slot in view of Voglers teaching because this arrangement would provide Sulcek with a means to insure a tight secure engagement of the upper margin of the panel within the retaining slot [note Vogler – col. 5 lines 15-27]. Furthermore, this arrangement is deemed a viable modification due in part to Sulcek's multiple panel configuration that is captured within the retaining slot. Sulcek utilizes a front panel (26) and "one or more additional panels (33) which may be selectively substituted for front

panel, as desired" [col. 3] and a spacer panel (34). In the event only one of the additional panels is in place adjacent the front panel, the incorporation of the positioning ribs within the retaining slot makes even more sense in support of an obvious modification due to the fact that the ribs would ensure positive engagement of the panels to the retaining slot in view of the absence of one additional panel or the spacer panel since the missing panels would present a larger void between the contact surfaces of the remaining panels and slot thereby injecting more room for the panels to move within the slot if the ribs were not present. This additional "wiggle" room would not be desirable in an environment where the outer panel needs to be flush to the door assembly and immovable.

Response to Arguments

4. Applicant's arguments filed September 29, 2008 have been fully considered but they are not persuasive.
5. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The examiner has gone on the record in the explanation of Sulcek's deficiency of positioning ribs within the retaining slot. Vogler clearly and unequivocally demonstrates the utilization of positioning ribs within a retaining slot in order to securely maintain panels within the slot. The same problem that applicant faced when securing

a panel within a retaining slot has been addressed within the citation to Vogler. As such, the examiner maintains the obviousness rejection as stipulated above and deems the rationale has been established for a *prima facie* case of obviousness.

6. In response to applicant's arguments that neither Sulcek nor Vogler, considered alone or in combination, describes an escutcheon as recited in claims 1 & 7, note the following: The Supreme Court Decision *KSR International Co. v. Teleflex Inc.*, 550 U.S.-, 82 USPQ2d 1385 (2007) forecloses the argument that a specific teaching, suggestion, or motivation be required to support a finding of obviousness, note *Ex parte Smith*, -- USPQ2d--, slip op. at 20, (Bd. Pat. & Interf. June 25, 2007) {citing KSR, 82 USPQ2d at 1396}. The Supreme Court in *KSR International Co. v. Teleflex Inc.* stated that the Federal Circuit erred when it applied the well-known teaching-suggestion-motivation (TSM) test in an overly rigid and formalistic way. Under the TSM test, a claimed invention is obvious when there is a teaching, suggestion, or motivation to combine prior art teachings. The teaching, suggestion, or motivation may be found in the prior art, in the nature of the problem, or in the knowledge of a person having ordinary skill in the art. According to the Supreme Court, the TSM test is one of a number of valid rationales that could be used to determine obviousness. It is not the only rationale that may be relied upon to support a conclusion of obviousness. Where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. 103(a). *Ex Parte Smith*, 83 USPQ. 2d 1509, 1518-19 (BPAI, 2007) (citing KSR v. Teleflex, 127

S.Ct. 1727, 1740, 82 USPQ. 2d 1385, 1396 (2007)). Applicant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ. 2d at 1518-19 (BPAI, 2007) (citing KSR, 127 S.Ct. at 1740, 82 USPQ. 2d at 1396. Accordingly, since the applicant[s] have submitted no persuasive evidence that the combination of the above elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a) because it is no more than the predictable use of prior art elements according to their established functions resulting in the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James O. Hansen whose telephone number is 571-272-6866. The examiner can normally be reached on Monday-Friday between 8-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 571-272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James O. Hansen/
Primary Examiner, Art Unit 3637

JOH
October 23, 2008